



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,839	06/16/2000	Daniel Schreiber	5015	1524

30256 7590 04/21/2004

SQUIRE, SANDERS & DEMPSEY L.L.P
600 HANSEN WAY
PALO ALTO, CA 94304-1043

EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/595,839

Applicant(s)

SCHREIBER ET AL.

Examiner

Jenise E Jackson

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 18, 27-30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 18, 27-30, 33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12 and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen in view of Andersen.

3. As per claims 12 and 27, Nguyen discloses providing a software application(i.e. applet) with an associated security authentication requirement to a client via a network(see col. 3, lines 31-39), although Nguyen discloses a unique identifier that is associated with an applet, Nguyen also discloses that a password may be associated with an applet, or other security authentication requirements(see abstract lines 15-16 and col. 3, lines 49-52), receiving a request from the software application(i.e. applet)via the network, because the web client(110) issues web commands(111) and those commands are sent to the web server(see col. 2, lines 46-47), the request includes an associated password(see col. 3, lines 49-52), because the client request a web document(121) that includes the information which the web server(120) transmits to the web client(110) for presentation to the user, and this information includes an applet(see col. 2, lines 61-65), further receiving from the program applet the associated password(see col. 3, lines 49-52), authenticating a password or unique identifier(see col. 3, lines 36-39, 49-52), providing the information to the software application(i.e. applet) via the network (see col. 3, lines 31-36), while the associated password is valid is inherent, because Nguyen discloses that no other further

Art Unit: 2131

information is provided unless one of a set of conditions is met; one of these conditions is a program applet can be limited to presenting the further information only if the user presents a selected authenticator, such as a password(see col. 3, lines 49-52), thus if the password is not valid the information will not be provided. Also, Nguyen inherently discloses an invalidation event, because Nguyen discloses, "only if the user presents a selected authenticator that is associated with a applet; therefore, if the user does not present an associated password, the password is invalidated(see col. 3, lines 49-52).

4. Nguyen does not disclose a software application via a network requesting for information stored at a restricted access storage area of a server.

5. However, Andersen discloses a software application(i.e. applet) that request information stored in a storage area of a server(see col. 1, lines 60-62, col. 4, lines 25-35).

6. After Nguyen downloads the applet on the client machine, if the client wants access to information, the applet contacts the server for permission; the applet must be authorized by a password that is checked against the server, to display the further information. Instead of letting the applet access the server, the applet would make its request to the server and the appropriate URL would be downloaded to it. Thus, copy protection would still exist, as the client would get desired information from the applet. Therefore, it would have been obvious to a person of ordinary skill in the art to modify the invention as disclosed by Nguyen to replace the feature of Nguyen that request to display the information of the applet with the feature of Andersen, that discloses a software application requesting information stored on a server, because Andersen recognizes the problem that giving JAVA applets free access on the network(i.e. software application) can give rise to a number of serious administrative and security problems(see col. 1,

lines 45-47). Further, Andersen discloses that if the applet was able to have free access to the full range of operating system calls accessed by application programs, then a web browser user could inadvertently download from the Internet a capricious program that disrupts the state of the client computer, including changing the client computer's configuration settings (etc..)(see col. 1, lines 47-52) Thus, it would have been obvious to modify Nguyen with the feature of Andersen, because Nguyen discloses an applet with access control, that has an associated password that must be validated by the server, and thus if the feature of Andersen that request information stored on the server, is modified with Nguyen, than the server is protected and only restricted to authorized software applications. Thus, the motivation to modify Nguyen with the feature of Andersen is that the applet is closely guarded and monitored, and its access to the server resources is severely restricted.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13-15, 18, 28-30, 33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen and Andersen in further view of Ananda as per claim 12 above.

9. As per claims 13, Nguyen and Andersen are silent on invalidating a password after a predetermined time, and after a predetermined elapse in time from when the request was received. However, Ananda discloses invalidating a password after a predetermined time, and

Art Unit: 2131

after a predetermined elapse in time from when a request was received(see col. 5, lines 5-8 and lines 22-25).

10. All three deal with providing a software application to a client. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Ananda with Nguyen and Andersen, because Ananda discloses invalidating a password after a predetermined time, and after a predetermined elapse in time. The motivation to do so is that it prevents a user from copying the application software to a storage device(see col. 5, lines 18-23 see Ananda).

11. As per claims 15 and 30, the Examiner takes Official Notice that it is well-known in the art of networking to invalidate a password upon detection of a loss of communication with the client, the motivation is that the password can be intercepted and used by another client on the network, if the password is not invalidated.

12. As per claims 18 and 33, Nguyen discloses generating the password at a server upon receiving the request at the server, although Nguyen discloses generating a unique id(see col. 3, lines 25-30), Nguyen also discloses that other authentication methods can be used, such as a password(see abstract, lines 14-17, and col. 3, lines 49-52).

Response To Amendment

13. Applicant's arguments filed 11/17/03 have been fully considered but they are not persuasive.

14. The Applicant states that the user does not present a password at all; the user is not even aware of what the password is. Further, the Applicant states that the applet does not check or validate a password; instead, the server computer that houses the proprietary data checks or

Art Unit: 2131

validates the password, prior to releasing such data. As per claim 12, the Applicant has not claimed these features. The Applicant has specifically pointed out figures 6 and 7 of specification. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applet does not check or validate a password; instead, the server computer that houses the proprietary data checks or validates the password, prior to releasing such data.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

15. Nguyen does disclose a embedding the password within the program applet, and provide the program applet embedded with the password to a client via a network; and receive a request for information and receive the password, for authentication from the program applet via the network, because Nguyen discloses each time the program applet executes to present the further information, it contacts the server(see col. 3, lines 34-36). The server associates the specific program applet having the unique ID with a set of conditions under which the program applet can display information, the user must present a password, this password is associated with the specific program applet(see col. 3, lines 45-53). The Examiner agrees that the user presents the password. However, the Examiner disagrees that the applet is not embedded within the password. The Examiner asserts that in order for a password to be validated, a password must be stored. Therefore, when the user presents the password is checked or validated with the *associated* password that is stored. Therefore, the Examiner asserts that the password is stored within the applet, and is therefore, embedded.

16. Second, the Applicant states that Andersen does not describe the use of passwords. The Examiner asserts that Andersen was not used for this limitation(see previous rejection, pg. 4).

17. Thirdly, in response to applicant's arguments against the references individually, on page 6, of paper 19, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

18. Lastly, the Applicant states that as per claim 27, the limitation of "wherein the server is operative to provide the software application assembled with the password to the client via a network is not disclosed in the references that were applied. The Examiner disagrees, Nguyen discloses receiving a request from the applet via the network, because the web client(110) issues web commands(111) and those commands are sent to the web server(see col. 2, lines 46-47), the request includes an associated password(see col. 3, lines 49-52), because the client request a web document(121) that includes the information which the web server(120) transmits to the web client(see col. 2, lines 61-65)(see previous rejection, pg. 1 also).

Cited Not But Applied

US(5,974,411)

US(6,260,480)

US(5,509,070)

US(5,875,296)

Final Action

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

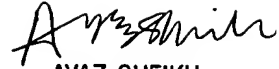
Application/Control Number: 09/595,839

Page 9

Art Unit: 2131

A handwritten signature, possibly reading "S. S.", in dark ink.

April 13, 2004

A handwritten signature in dark ink, appearing to read "Ayaz Sheikh".

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100